<center>REMARKS</center>

Claims 1-4, 7-17 and 20-31 are now pending in the present application. Claims 1, 3, 14, 16, 24 and 27 have been amended, and Claim 31 has been added, herewith. No new matter has been added by any of the amendments. Reconsideration of the claims is respectfully requested.

I.   35 U.S.C. § 112, First Paragraph

The Examiner rejected Claims 3, 4, 7-11, 16, 17, 20-24, and 29 under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed.

The Examiner states that the Specification does not disclose first and second servers, or distinct data and control paths. Claim 3 is being reproduced herewith, **with specific reference to the Specification and Figures being included for *each claimed element* recited in Claim 3**.

Claim 3:

The method of claim 1, wherein the first automated data storage system is a source automated data storage system **(FIG 6, element 620)** coupled to a first server **(FIG 6, element 606)** via a source data path **(FIG 6, element 614)** and a source control path **(FIG 6, element 618)**, wherein the second automated data storage system is a destination automated data storage system **(FIG 6, element 628)** coupled to a second server **(FIG 6, element 610)** via a destination data path **(FIG 6, element 622)** and a destination control path **(FIG 6, element 626)**, wherein the source data path is distinct from the destination data path **(FIG 6, elements 614 and 622)** and the source control path is distinct from the destination data path **(FIG 6, elements 618 and 622)**, and wherein the source automated data storage system and the destination automated data storage system are each physically connected to a pass-through port **(FIG 6, element 630)**

The above listed features of Claim 3 are also described at **Specification page 22, line 14 – page 23, line 19**. Therefore, the rejection of Claim 3 under 35 U.S.C. § 112, first paragraph is shown to be in error, as all features recited therein are disclosed in the Specification and depicted in the drawing *as shown above*.

With respect to Claim 4, the source control data set and the destination control data set are shown, respectively, at **elements 608 and 612 of FIG 6** and described at **Specification page 22, lines 19-20**. Therefore, the rejection of Claim 4 under 35 U.S.C. § 112, first paragraph is

shown to be in error, as all features recited therein are disclosed in the Specification and depicted in the drawing.

Applicants traverse the rejection of Claims 7-11, 16, 17, 20-24 and 29 for similar reasons to those given above with respect to Claims 3 and 4.

Therefore, the rejection of Claims 3, 4, 7-11, 16, 17, 20-24 and 29 under 35 U.S.C. § 112, first paragraph has been overcome.

II.   35 U.S.C. § 102, Anticipation

The Examiner rejected Claim 30 under 35 U.S.C. § 102(b) as being anticipated by Munro (US Patent No. 4,864,438). This rejection is respectfully traversed.

Claim 30 recites a specific feature of "a transportation device that transports the data storage unit from the first data storage device to the second data storage device, wherein the transportation device protects against transporting the data storage unit from the second data storage device back to the first data storage device". As can be seen, per Claim 30 the transportation device *protects against* transporting the data storage unit from the second data storage device back to the first data storage device. In rejecting this aspect of Claim 30, the Examiner cites Munro's teachings at col. 14, lines 59-67; col. 15, lines 1-30; col. 16, lines 26-51; and the Abstract as teaching this claimed feature. Applicants urge that to the contrary, the cited Munro reference does not teach any step of *protecting against* transporting the data storage unit from the second data storage device back to the first data storage device, and in fact specifically teaches that the data cartridge *can be returned to its home position over the original selected path* (col. 16, lines 31-36), and thus does not teach the claimed 'protect against' feature as it specifically allows such action to occur. Thus, Claim 30 has been erroneously rejected under 35 U.S.C. § 102(b), as every element of the claimed invention is not identically shown in a single reference.

It should be further noted that the Munro passage cited by the Examiner in rejecting Claim 30 describes the movement of a cartridge from a source library module and a destination library module. Such passage does <u>not</u> describe *any type of transportation device that <u>protects</u> against transporting a data storage unit from a second data storage device back to a first data storage device*, as expressly recited in Claim 30. For a prior art reference to anticipate in terms of 35 U.S.C. 102, <u>every element</u> of the claimed invention must be *<u>identically</u> shown* in a single

reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (emphasis added). As the cited reference does not teach a transportation device (which transports the data storage unit from a first data storage device to a second data storage device) that *protects against transporting a data storage unit from the second data storage device back to the first data storage device*, the cited reference does not anticipate Claim 30.

In rebuttal to the above arguments, the Examiner describes many things that the cited reference does *not* disclose to rationalize the present rejection ('the reference does *not* disclose that the data cartridge is returned from the second storage device to the first storage device' (emphasis added by Applicants); per line 16 of the Examiner's comments on the Continuation Sheet for the Advisory Action dated 4/3/2006,). Applicants urge error in relying on what a reference does *not* disclose to establish a specific teaching of a specific claimed feature. For example, and by analogy, assume a claim is directed to a carburetor governor device that prevents a car from exceeding a certain speed, such as 50 MPH. Also assume a reference that describes a car traveling at 40MPH. The reference does not anticipate the claim even though the reference does not describe driving over 50 MPH, as the reference does not describe the governor device that prevents a car from exceeding a certain speed. Restated – *the absence of disclosure does not explicitly teach an active step/apparatus for preventing steps not disclosed*. For the present case, the fact that Munro does *not* teach the transport of a data storage unit from the destination library to the source library does not establish any teaching of *a device that protects against such transport*.

Therefore, the rejection of Claim 30 under 35 U.S.C. § 102(b) has been overcome.

III.   35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-29 under 35 U.S.C. § 103 as being unpatentable over Honma et al (US Publication 2004/0073676) in view of Munro (US Patent No. 4,864,438). This rejection is respectfully traversed.

Claim 1 has been amended to recite that the data storage units that are transported by the second robotic mechanism are contained in the second automated data storage system, as described in the Specification at page 3, lines 9-23; page 4, lines 8-16; et seq.

Claim 1 has also been amended to recite that the data storage units contained in the second automated data storage system are not allowed to be transported to the first automated data storage system, as described in the Specification at page 24, lines 12-16 et seq.

With respect to Claim 1, it is urged that the cited references do not teach or suggest the claimed feature of "wherein the first automated data storage system is an unclassified data storage system and wherein the second automated data storage system is a classified data storage system that complies with a government security classification". Due to the Munro architecture, there is no ability to provide such a secured environment, *as the LSM's share a common network* (Figure 1, elements 162 and 163) with no ability to only allow data flow to a high security level but not allow data flow to a lower security level (Specification page 6, lines 11-16). The Munro architecture is expressly required to allow unfettered data sharing between the LSMs (see Munro column 3, lines 14-27, where it states "Thus, by coordinating the operation of a plurality of automated tape cartridge library modules, each and every tape cartridge in the library can be mounted *on any* selected tape drive unit *in the entire complex*"), and to reserve particular paths for efficient transport between such LSMs (Munro column 6, 12-38), both of which are expressed purposes/advantages of the Munro teachings. To somehow re-architect the teachings of Munro to provide a classified environment would eviscerate the Munro's path reservation system and unfettered access to media within the entire complex, evidencing no motivation to modify the teachings of Munro in accordance with the claimed invention. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As described above, there would have been no motivation or desire to modify the Munro teachings in accordance with the missing claimed features recited in Claim 1, and thus Claim 1 is not obvious in view of the cited references. Further, while the cited Honma reference alludes to providing data storage restrictions using a front-end fiber channel switch, such teaching does not teach or suggest *both* an unclassified and a classified automated data storage system that complies with a government security classification, as expressly recited in Claim 1. For example, as described by Honma (1) at page 2 paragraph 0037, the server sides are enabled to access all of the storages *without any restriction*, and (2) at page 3 paragraph 0038, if a copy of data at the main and remote sites is retained at each other site, even when either site fails due to a disaster, etc., jobs can continue to run *using the data at*

the other site. While Honma briefly alludes to security concerns for data at page 10, paragraphs 0104-0106, access to data is controlled in a totally different fashion using a separate fiber channel switch which limits access to the data. This teaching does not teach or suggest *both* an unclassified and a classified automated data storage system that complies with a government security classification, as expressly recited in Claim 1. Thus, the cited Honma reference does not overcome the deficiencies described above with respect to the cited Munro reference.

Further, the fact that the Honma reference describes restricted paths to access data storage (such restriction being accomplished by a separate fiber channel switch) does not provide any motivation *to modify the teachings of the cited Munroe reference* in accordance with the claimed invention. Restated, a mere teaching of security concerns in one reference does not provide motivation to modify another reference which has no security classification concerns. To find otherwise would effectively eliminate the teaching/suggestion/motivation requirement that is expressly required by well-established case law, as any reference that describes 'anything' could be used as motivation to modify another reference to include the 'anything' even though the another reference is not concerned with the 'anything'. This certainly is not the law regarding a requirement for a motivation to modify a reference, as such an interpretation would effectively eliminate the motivation requirement as motivation would always exist no matter what. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). Still further, Claim 1 has been amended to recite the unilateral transport of data storage units which is provided by the present invention in order to meet security requirements. None of the cited references teach or suggest any type of system which provides such security, and thus it is further urged that Claim 1 is not obvious in view of the cited references.

Applicants initially traverse the rejection of Claims 2-4 and 7-13 for reasons given above with respect to Claim 1 (of which Claims 2-4 and 7-13 depend upon).

Further with respect to Claim 3, it is urged that none of the cited references teach or suggest the particular claimed configuration recited therein, where the first automated data storage system is a source automated data storage system that is coupled to a first server via a source data path and a source control path, and where the second automated data storage system is a destination automated data storage system that is coupled to a second server via a destination

data path (distinct from the source data path) and a destination control path (distinct from the source control path), the source automated data storage system and the destination automated data storage system each being physically connected to a pass-through port. Importantly, the source and destination data paths are distinct from one another, as are the source and destination control paths, with the source data and control paths providing the coupling between the source automated data storage system and the first server and the destination data and control paths providing the coupling between the destination automated data storage system and the second server, in order to advantageously provide an improved sharing technique for a multiple gateway automated data storage system. In contrast, per the teachings of Munro (which are being relied upon to reject all features of Claim 3), a common control path (FIG 1, element 161) is connected to both host computers 101 and 102 (col. 4, lines 36-39). Thus, it is further urged that amended Claim 3 is not obvious in view of the cited references.

Applicants initially traverse the rejection of Claims 14-17 and 20-29 for similar reasons given above with respect to Claim 1.

Further with respect to Claim 14 (and similarly for dependent Claims 15-17 and 20-26), such claim has been amended to specifically recite that the pass-thru port (that interconnects the first automated data storage system with the second automated data storage system) prevents the data storage units contained in the second automated data storage system from being transported to the first automated data storage system, as described in the Specification at page 24, lines 12-16 et seq. None of the cited references teach or otherwise suggest this claimed feature, and thus it is further urged that Claim 14 is not obvious in view of the cited references.

Applicants further traverse the rejection of Claim 16 for similar reasons to the further reasons given above with respect to Claim 3.

With respect to Claims 6-7 and 18-19, such claims have previously been cancelled.

Therefore, the rejection of Claims 1-29 under 35 U.S.C. § 103 has been overcome.
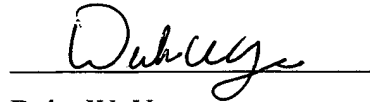

IV.   New Claim

Claim 31 has been added herewith, and examination of such claim is respectfully requested.

V.   <u>Conclusion</u>

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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